

REMARKS

Claims 1-21 are currently pending in this application. By this amendment, claim 19 is amended to depend from claim 11, rather than claim 10, so as to resolve an antecedent basis problem noted in that claim. No new matter is added. Reconsideration and allowance of this application are respectfully requested in view of the above amendment and the following remarks.

Allowed Claims

Applicants appreciate the indication that claims 3-7 and 11-21 contain allowable subject matter. However, Applicants submit that all of the claims are in condition for allowance for the following reasons.

Objections to the Specification and the Previous Amendment

In the Office Action, the Amendment filed December 4, 2002 was objected to under 35 U.S.C. § 132 because it allegedly introduced new matter into the disclosure. Additionally, the specification was objected to as allegedly failing to provide proper antecedent basis for the amendments made to claim 1. In particular, the Examiner asserts that the specification does not provide support for the feature of claim 1 that “the diameter of the vent hole is between 0.003 and 0.02 inches.” Applicants respectfully disagree with the Examiner’s assertion that that feature represents new matter and respectfully submit that the December 4, 2002 amendment did not introduce any new matter into the specification.

Applicants respectfully submit that although the specification may describe certain vent hole diameter ranges as being preferable, the specification does provide support for the range of approximately between 0.003 and 0.02 inches.

For example, Applicants direct the Examiner’s attention to Table 8, which is located on pages 15 and 16 of the specification, as well as Figures 10, 11, and 13, which are graphical representations of the data found in Table 8 and the other tables in the specification. Table 8 clearly shows data covering the entire claimed range of 0.003 inches to 0.02 inches by starting at 0 and ending at 0.0775 inches. Additionally, Applicants note that the abscissa on Figures 10, 11,

and 13 begins at a diameter of 0 inches and ends at a diameter of 0.07 inches. Therefore, Applicants have clearly provided data that covers the entire claimed range.

To the extent that certain of the Applicants' examples and data points are actual experimental results while others are projected or prophetic, Applicants remind the Examiner of the statement in MPEP § 2164.02 that:

Compliance with the enablement requirement of 35 USC § 112, first paragraph does not turn on whether an example is disclosed.

An example may be 'working' or 'prophetic.' A working example is based on work actually performed. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved.

Accordingly, Applicants respectfully submit that, as a matter of law, the specification adequately supports and enables the claims, and that the amendment of December 4, 2002 did not introduce any new matter. Therefore, Applicants respectfully request that the objection be withdrawn.

Objection to the Claims

Claim 19 was objected to because it allegedly did not provide support for the term "plug" as recited in the claim. Applicants have amended claim 19 to depend from claim 11, rather than from claim 10, and respectfully submit that the objection has been overcome. Accordingly, Applicants respectfully request that the objection be withdrawn.

35 U.S.C. §102 Rejection

Claims 1-2 and 10 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by US Patent No. 5,817,050 issued to Klein. Applicants respectfully traverse this rejection.

In order to anticipate a claim, a patent or other prior art reference must disclose each and every feature recited in that claim. Claim 1 recites, *inter alia*, "an opening acting as a vent hole positioned along the length of the tube away from the assembly, the vent hole having a diameter of approximately between 0.003 and 0.02 inches and which allows air to flow within the bore of the tube." Applicants respectfully submit that Klein does not disclose at least that feature.

In making the rejection, the Examiner asserts that one of the more distal apertures in the tip of the Klein cannula, specifically “the opening to the left of reference character 12 in Figure 3” constitutes an opening acting as a vent hole in claim 1. Applicants respectfully disagree.

First, at column 3, lines 29-30 of Klein, the apertures 14 are disclosed to “have a diameter of about 1/32 of an inch to about 1/16 of an inch.” That range, which translates to between 0.03125 inches and 0.0625 inches, falls outside of Applicants’ claimed range. However, regardless of the particular range of measurements, Applicants respectfully submit that the apertures 14 are not openings acting as ventholes as recited in claim 1; rather, they are openings meant to help separate and remove adipose tissue. At column 3, lines 59-63, Klein explains that

such movement provides a rasping force by the apertures 14 on the adipose tissue and thereby facilitates adipocyte disassociation from surrounding fibrous tissue. Adipose tissue so presented enters the interior 16 of the tube 12 through the apertures 14 for final removal.

Applicants do note, however, that Klein does disclose a “thumb hole,” which is identified as reference numeral 28, and which is provided as part of the handle, rather than as part of the cannula tube.

Accordingly, Applicants respectfully submit that Klein does not anticipate independent claim 1 or dependent claims 2 and 10, and respectfully requests that the rejections be withdrawn.

Rejection 35 U.S.C. §103

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Klein. Applicants respectfully traverse this rejection.

In order for a prior art reference or combination of references to render a claim obvious, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all the claim limitation. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant’s disclosure.

Applicants note that claims 8 and 9 depend from claim 1, and respectfully submit that Klein does not disclose or suggest all of the features of claim 1 for at least the reasons given

above with respect to the 35 U.S.C. §102(b) rejection. Therefore, because claims 8 and 9 depend from claim 1 and incorporate all of its features by reference, Applicants respectfully submit that Klein does not render claims 8 and 9 obvious, regardless of what it may or may not disclose with respect to mass flow rates. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all claims are allowable over the cited references, and that the application itself is in condition for allowance. The Examiner is respectfully requested to pass this application to issue. The Examiner is invited to contact the undersigned at the telephone listed below, if needed. Applicants hereby make a written conditional petition for an extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,



Andrew M. Calderon
Registration No. 38,093

Andrew McAleavey
Registration No. 50,535

McGuireWoods, LLP
Suite 1800
1750 Tysons Blvd.
McLean, VA 22102
(703) 712-5426